Remarks:

Reconsideration of the application is respectfully requested.

Applicant would like to thank Examiner Porter for the courtesy shown to Applicant's representatives in the telephonic interview of April 26, 2006.

Claims 97 - 123 are presently pending in the application. Claims 75 - 96 have been canceled. Claims 1 - 74 were previously canceled. New claims 97 - 123 have been added.

I. The methods of Applicant's independent claims 97, 101 and 119 are statutory subject matter under 35 U.S.C. § 101.

In item a final Office Action mailed January 26, 2006 (the "**final Office Action**"), Applicant's former claims 75 - 96 were alleged to be non-statutory subject matter. Applicant has canceled claims 75 - 96 from the instant application, thus mooting the above rejection. Applicant's newly presented claims are believed to be statutory subject matter under 35 U.S.C. § 101. In each claim, at least some information is **outputted**, thus creating something useful, concrete and tangible.

Fore example, Applicant's independent claim 97 recites a computer-implemented **method** for assembling a prescription, the method comprising:

electronically storing a patient identifier in a computer memory medium;

electronically associating a drug selected from a list of drugs approved by a drugs benefit provider with the patient identifier;

electronically associating a dosage for the selected drug, with the patient identifier and the selected drug; and

retrieving **and outputting** the associated selected drug and dosage associated with a patient identifier.

Applicant's independent claim 101 recites a **method** for assembling an electronic prescription, comprising the steps of:

electronically retrieving a patient identifier converted to electronic data;

electronically retrieving the identity of at least one prescribed drug associated with the patient identifier, the at least one prescribed drug being selected from a list of drugs approved by a drugs benefit provider;

electronically retrieving a dosage for the at least one prescribed drug associated with the at least one prescribed drug and the patient identifier; and

storing the at least one prescribed drug, the dosage and the patient identifier in an electronic memory; and

outputting at least the at least one prescribed drug.

Applicant's independent claim 119 recites a **method** for aggregating electronic prescription data, comprising the steps of:

> electronically storing at least a first patient record including at least one prescribed drug selected from a list of drugs approved by a drugs benefit provider and a prescriber identifier representing the user that selected the at least one prescribed drug;
>
> electronically storing at least a second patient record including at least one prescribed drug selected from a list of drugs approved by a drugs benefit provider and a prescriber identifier representing the user that selected the at least one prescribed drug;
>
> aggregating data from the at least a first patient record with data from the at least a second data patient record to form an aggregated data record; and
>
> outputting the aggregated data record.

Pursuant to MPEP § 2106, methods, even those involving computers, can be the subject of statutory subject matter. More particularly, Applicant's methods of claims 99, 101 and 117 accomplish a practical application, i.e., the methods produce a "useful, concrete and tangible result". One example of a method that was found to be statutory subject matter is given in MPEP § 2106, as follows:

> -"[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, [citations omitted]

As with the above example, Applicant's methods, create a tangible result, i.e., a prescription including a prescribed drug and dosage, associated with a patient identifier, which

prescription can be used to fill a drug order or assist in future dealings with the patient (i.e., by using the information for diagnosis and/or for preventing drug interactions, etc.). The aggregated prescription data of claim 117 is additionally useful. For example, the aggregated data can be used for market research purposes, as well as to analyze and optimize users' prescribing practices. This is supported in paragraph [0107] of the instant application, which states:

> Of commercial note is that **the foregoing data may be aggregated for multiple users**, for example by the host computing facility, **for market research purposes. Also, an individual user's prescribing patterns may be reviewed by the user or by others**. For example, drug benefits companies, can review the user's prescribing patterns for formulary compliance and respond by encouraging better compliance, where appropriate. Release of such data to third parties can be controlled to safeguard the privacy of the prescriber, or other health care provider, by prescriber-determined data access protocols specifying who, or what organization, department or group, may access what data, when they may access it and what they can do with it. For example, one physician may permit academic use for research studies and prohibit commercial use while another may permit either. [emphasis added by Applicant]

Further, the data of claims 97, 101 and 119 may be used to produce and output reports. For example, paragraphs [0267] and [0268] of the instant application state:

> Naturally the prescription management system of the invention **can provide a variety of printed reports and other data outputs** of any facet of the described operations. In some cases, these reports can be enhanced to provide entirely new products for example

> a dosing schedule such as that described with reference to FIG. 15, and shipping schedules or split prescriptions divided according to suppliers requirements.
>
> **Current and historical reports can, subject to the access controls described herein, be patient-specific, prescriber-specific or organization-specific and can be aggregated across various groups, pools, geographical regions, conditions, drugs, or time periods or combinations of any of the foregoing** to provide a valuable data resource to health care providers, patients, managed care organizations, government agencies and others. [emphasis added by Applicant]

Further, information derived from the patient data can be sold, as claimed in claim 123. This is supported in paragraph [0167] of the instant application, which states:

> **Outcome studies produced by the system may have substantial value to various parties, and their sale can support system costs, as may formulary compliance savings.** For example, drug efficacy data is of value to pharmaceutical companies, as is early warning data from reliable specialists regarding adverse reactions. Subject to confidentiality and other relevant controls, such data can be automatically compiled and readily supplied by system management, requiring only approval, not active participation by involved physician prescribers. Equally, the system may facilitate clinical trials by identifying health care providers or prescribers who would be likely participants in trials, based upon their having frequently diagnosed relevant conditions, or specified relevant drugs, as shown by their historical prescribing profiles, or relevant patient histories. Suitable patient pools can be identified similarly. [emphasis added by Applicant]

See also, paragraph [0107] of the instant application, last sentence, which states:

> For example, one physician may permit academic use for research studies **and prohibit** <u>commercial use</u> **while another may permit either.** [emphasis added by Applicant].

Thus, the **methods** of claims 97, 101 and 119 produce a tangible result and, thus, are patentable statutory subject matter, and not merely descriptive material.

As such, it is believed that claims 97, 101 and 119, and the claims depending therefrom, meet the requirements of 35 U.S.C. § 101.

II. Applicant's new claims are believed to be definite under 35 U.S.C. § 112

In item 6 of the Office Action, claims 75 - 96 were rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, it was alleged in the Office Action that it was unclear whether the applicant intends to claim the prescription or the prescription creation system. Applicant has canceled claims 75 - 96, thus, it is believed, mooting the instant rejection. New claims 97, 101 and 119, and the independent claims depending therefrom, are clearly directed to a **method**. Thus, it is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph.

III. Applicant's claimed invention predates SCHRIER.

In the **final Office Action**, the declarations filed under 37 C.F.R. § 1.131 were considered but allegedly ineffective to overcome U. S. Patent No. 5,833,599 to Schrier ("**SCHRIER**"). In the telephone interview of April 26, 2006, the declarations were discussed and it was understood that the alleged ineffectiveness of the 37 C.F.R. § 1.131 declarations was linked to the 35 U.S.C. §§ 101 and 112 rejections of the claims, because it was unclear to the Examiner what was being claimed. Applicant will show herein, that the previously filed declarations, and the underlying proofs, show that the invention of the newly filed claims was conceived prior to the priority date of **SCHRIER** and was diligently reduced to practice with the filing of a patent application from which the present application claims priority.

More particularly, in item 9 of the **final Office Action**, claims 75 - 85, 87 and 89 - 95 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U. S. Patent No. 5,833,599 to Schrier ("**SCHRIER**"). In item 11 of the Office Action, claims 86, 88 and 96 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **SCHRIER**.

Applicant respectfully traverses the above rejections.

First, Applicant has canceled claims 75 - 96 from the instant application, thus mooting the specific rejections of **final Office Action.**

However, Applicant notes that Applicant's conception of the currently claimed invention predates the filing of the **SCHRIER** reference, as evidenced by Applicant's previously submitted Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome a Cited Patent or Publication under 37 C.F.R. § 1.131, executed by Applicant on June 4, 2004, setting forth the prior conception of the claimed invention ("**the conception declaration**"). Further, Applicant pursued the claimed invention with diligence from prior to the time of filing of the **SCHRIER** reference, until the filing of the application from which the present case claims priority, as evidenced by Applicant's previously submitted Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome a Cited Patent or Publication under 37 C.F.R. § 1.131, executed on January 25, 2005, and setting forth the Applicant's diligence in pursuing the claimed invention ("**the diligence declaration**").

Note that, although **the conception declaration** and **the diligence declaration** were originally filed in a sister case to the present one, **both declarations equally support the**

prior conception and diligence of Applicant with regard to the presently claimed invention.

As proof thereof, Applicant offers the following. The **SCHRIER** reference has a filing date of April 9, 1996, and claiming priority from an application filed on **December 13, 1993**. Paragraph 3 of Applicant's **conception declaration** states:

> 3. On a date prior to December 13, 1993, I made a confidential presentation to a third party regarding my invention then called "Physicians' Online." In support for that presentation, I provided a handout, a copy of which is attached hereto as Exhibit A, (all dates on submitted materials have been redacted,) this handout material is numbered POL 03771 through POL 03783. This handout, Exhibit A, bears a printed date thereon (redacted) at page marked POL 03771, which shows the date that the meeting took place, a date prior to December 13, 1993. In further support of the date of this said meeting, attached hereto as Exhibit B, document no. POL 05667, is a copy of two pages from my personal calendar. In my writing there is displayed on the left side a morning entry, showing my "9:30" meeting (third party name and meeting location redacted) which date, printed on my calendar (redacted), is prior to December 13, 1993. This corroborates the date on the handout and the date the meeting took place prior to December 13, 1993. Other writings on this Exhibit B sheet reflect my notes of the parties in attendance in the meeting.

Paragraphs 4 - 9 of the **conception declaration** detail further confidential meetings and/or facsimile transmissions occurring on dates prior to December 13, 1993 and including handouts that evidenced Applicant's conception of the invention prior to December 13, 1993. These handouts were additionally

previously provided in the instant application as attachments to the conception declaration.

Referring to the attachments prepared for and provided at meetings prior to December 13, 1993, it will be shown that the invention of the instant claims was conceived by Applicant prior to December 13, 1993.

Claim 97	Claim 101	Exhibits to the Conception Declaration
A computer-implemented method for assembling a prescription, the method comprising:	A method for assembling an electronic prescription, comprising the steps of:	By seamlessly integrating all the information relevant to making informed therapeutic decisions (including relevant formularies, price lists, drug information, and potential drug interactions) at the "point-of-sale," our "Smart Electronic Prescription Pads" and personalized prescription management software intelligently automate the prescription-writing, tracking and fulfillment process to facilitate cost-effective therapeutic decision-making. As full featured communication terminals, our PDA can access all of our other online information products and services as well. **Exhibit F, POL 02248** . . . PPN will rely on a new class of electronic devices known as Personal Digital Assistants (PDAs). PDAs are low-cost easy-to-use pocket-sized pen-based computers which allow mobile professionals such as

Claim 97	Claim 101	Exhibits to the Conception Declaration
		physicians to communicate from anywhere over wireless networks. **Exhibit G, THB 06012** **See also Exhibit E, POL 03312 - 03313.**
electronically storing a patient identifier in a computer memory medium; electronically associating a drug selected from a list of drugs approved by a drugs benefit provider with the patient identifier; electronically associating a dosage for the selected drug, with the patient identifier and the selected drug; and	electronically obtaining a patient identifier converted to electronic data; electronically retrieving the identity of at least one prescribed drug associated with the patient identifier, the at least one prescribed drug being selected from a list of drugs approved by a drugs benefit provider; electronically retrieving a dosage for the at least one prescribed drug associated with the at least one prescribed drug and the patient identifier;	1. Online Formulary: With the cooperation of the leading companies that manage prescription drug benefit programs, PPN links the physician with the various formularies through an electronic prescription pad ("Smart Script") which helps the physician identify the preferred prescription choices at the point of prescription writing. PPN's proprietary Smart Scripts software allows for continuous updating of formularies and seamless integration into the prescription writing process. No matter which plan a patient is covered by, while the physician is writing a prescription, he is made aware of any therapeutic alternatives at the appropriate time. This will obviate the need for pharmacists to retrospectively contact the physician about such alternatives. **Exhibit G, THB 06012** **See also Exhibit C, THB 12202; Exhibit D, THB 08067.**
retrieving and outputting the associated selected drug and dosage associated	storing the at least one prescribed drug, the dosage and the patient	3. Electronic Transmission of Prescriptions to Pharmacists: Through the link with the pharmaceutical benefit programs, the patient can direct the prescription to

Claim 97	Claim 101	Exhibits to the Conception Declaration
with a patient identifier.	identifier in an electronic memory; and outputting at least the at least one prescribed drug.	the retail or mail-order distribution outlet of their choice. This linkage will eliminate paper and patient time at the pharmacy. **Exhibit G, THB 06012**

Claim 119 is additionally supported by the exhibits to the **conception declaration**. For example, aggregating prescription data, as claimed in Applicant's claim 119 is supported in Exhibit E, POL 03296, under "Competitive Advantage" "Phase II", wherein the system is described as providing "Proprietary Prescriber Profiling" and "Patient Prescription Profiles", both of which require aggregating data as claimed in claim 119. See also, "Physician Psychometric Data" Exhibit E, POL 03348 ("By coupling this data with **prescribing practices data**, the pharmaceutical industry now has a complete and potent marketing methodology available to them."). See also, Exhibit F, POL 02271 which states, in part:

> This trend is our market opportunity. *Physicians' Online* provides a medium which naturally complements pharmaceutical micromarketing services by providing a true physician-level targeted medium. An alliance with a prescriber-level prescription data provider allows us to strengthen our targeting features by including direct "prescription behavior targeting." In addition to targeting demographics and context, **physicians can also be targeted by their specific drug prescribing practices.** [emphasis added by Applicant]

Additionally, as it has been shown in the diligence declaration that Applicant was diligent in pursuing claim 70 of the '681 application, it can be seen that the same diligence applies to the new claims of the instant application.

Thus, it is believed that the SCHRIER reference is not properly citable against the claims of the instant application, as Applicant can prove prior conception of the claimed invention, as well as, diligent reduction to practice.

As such, it is believed that claims 97 - 123 are in condition for allowance.

It is accordingly believed that none of the references that are prior art to the presently claimed invention, whether taken alone or in any combination, teach or suggest the features of claims 97, 101 and 119. Claims 97, 101 and 119 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they depend from claims 97, 101 or 119.

In view of the foregoing, reconsideration and allowance of claims 97 - 123 are solicited.

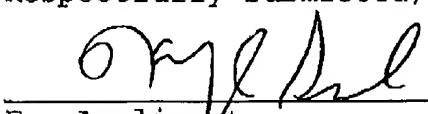
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

The instant Amendment is additionally being provided with a Request for Continuing Examination and its associated fee. Please additionally consider the present as a petition for a one month extension of time, and please provide a one month extension of time, to and including, May 26, 2006.

The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of $120.00 in accordance with Section 1.17 is enclosed herewith.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Robert M. Schwartz, P.A., No. 19-0734.

Respectfully submitted,



Kerry P. Sisselman
Reg. No. 37,237

For Applicant
May 26, 2006

2445 Hollywood Blvd.
Hollywood, FL 33020
Tel: (954) 925-1100
Fax: (954) 925-1101